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PATENT
Customer No. 22,852
Attorney Docket No. 08806.0173-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Hakan SWAHN et al.) Group Art Unit: 2834
)
Serial No.: 10/522,606) Examiner: Iraj A. MOHANDESI
)
Filed: January 28, 2005)
) Confirmation No.: 8947
For: ELECTRIC MACHINE)
)

✓ Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In an Office Action mailed May 15, 2006, the Examiner required restriction under
35 U.S.C. § 121, as follows:

- | | |
|-----------|---|
| Group I | Claims 1-15, characterized by the Examiner as being drawn to a method of monitoring a rotating synchronous electric machine; |
| Group II | Claims 16-23, characterized by the Examiner as being drawn to a control apparatus for a rotating electric machine; and |
| Group III | Claims 24 and 25, characterized by the Examiner as being drawn to a memory medium for a computer program for controlling an electric machine. |

Applicants respectfully traverse the restriction requirement and request withdrawal of the restriction requirement because the Office Action has not presented a prima facie case for the restriction requirement. As referenced by the Examiner on page 2 of the Office Action, the M.P.E.P. states that

[I]nventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product.

M.P.E.P. § 806.05(h) (emphasis added).

On page 2 of the Office Action, it appears that the Examiner is alleging that the processes recited in Group I can be practiced with another product materially different from the products recited in Groups II and III. Specifically, the Examiner alleges that a “rotating machine can be controlled by sensors and detectors rather than computer.” However, claims 16-23 in Group II do not recite “computer,” but instead recite a “control apparatus.” A “control apparatus” may include an apparatus of sensors and detectors. Hence, the Examiner’s allegations that the processes recited in Group I can be practiced with another product (i.e., the alleged “sensors and detectors”) materially different from the products recited in Group II (e.g., the control apparatus) is incorrect. That is, a “control apparatus” in Group II is not materially different from sensors and detectors, because a “control apparatus” is not limited to computers, but instead, may include apparatuses with sensors and detectors. Further, even if the claims in Group II or III were limited to a “computer” controlling apparatus, the Examiner has not provided a prima facie case demonstrating that a “computer” controlling apparatus is materially different from “sensors and detectors.”

On page 2 of the Office Action, the Examiner further alleges a “computer controlling apparatus can be used in several mechanical or electrical process [sic] such as navigating a plane or a crane or a robot [sic].” It appears that the Examiner is alleging that the products in Groups II and III can be used in processes materially

different from the processes in Group I. However, the claims in Groups II and III do not simply recite a control apparatus (which may or may not happen to be usable in a “plane,” “crane,” or “robot”). Rather, claim 16, for example, recites a “control apparatus for controlling a rotating synchronous electric machine” where the “control apparatus is arranged to transmit control signals for controlling at least one variable in the electric machine in dependence on the signals on the [stator current, stator voltage, rotor current, and coolant temperature] signal inputs and using a model . . . to estimate the temperature in at least two positions in the electric machine.” The Examiner has not demonstrated how such a control apparatus in claim 16 can be used in processes materially different from the processes in Group I. That is, the Examiner has not demonstrated how the control apparatus “arranged to transmit control signals for controlling at least one variable in the electric machine in dependence on the signals on the [stator current, stator voltage, rotor current, and coolant temperature] signal inputs and using a model . . . to estimate the temperature in at least two positions in the electric machine” as recited in claim 16, can be used in processes materially different from processes that comprise “determining the stator winding current, determining the stator winding voltage, determining the rotor winding current, measuring the coolant temperature, and estimating the temperature in at least two positions” as recited in claim 1.

Accordingly, for at least the above reasons, the Examiner has not shown that the processes in Group I can be practiced with another product materially different from the products in Groups II and III, and has not shown that the products in Groups II and III can be used in processes materially different from the processes in Group I. Hence, the

Examiner has not presented a prima facie case requiring restriction of the claims to Groups I, II, and III.

Further, Applicants note that "if the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added). The search required to properly examine the claims of one of Groups I-III would necessarily overlap a search required to properly examine the claims of the remainder of Groups I-III. Accordingly, it would not constitute an undue burden to search all of the claim Groups together.

For the above reasons, Applicants request that the Examiner reconsider and withdraw the restriction requirement. If the Examiner declines to withdraw the restriction requirement, Applicants request that the Examiner indicate the finality of the restriction requirement so that Applicant will be able to submit a Petition under 37 C.F.R. § 1.144 to the Group Director requesting review of this requirement. In the interim, Applicants provisionally elect to prosecute Group I, claims 1-15 **with traverse**.

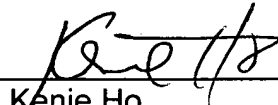
Finally, Applicants note that the Office Action contains various allegations concerning the claims. Regardless of whether any such allegation is addressed specifically herein, Applicants decline to automatically subscribe to any allegation, assertion, and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 14, 2006

By: 
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